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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,040	01/13/2006	Takeshi Kodu	8048-1103	7898

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YOUNG & THOMPSON
209 Madison Street
Suite 500
Alexandria, VA 22314

EXAMINER

TEKLE, DANIEL T

ART UNIT	PAPER NUMBER
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2621

NOTIFICATION DATE	DELIVERY MODE
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04/02/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DocketingDept@young-thompson.com

Office Action Summary	Application No. 10/530,040	Applicant(s) KODA ET AL.	
	Examiner DANIEL TEKLE	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 13 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim 1-6 and 13-16 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

3. The claim recites, *inter alia*, “A computer readable storage medium having a computer readable program stored thereon that is ...” After close inspection, the Examiner respectfully notes that the disclosure, as a whole, does not specifically identify what may be included as a computer readable storage medium and what is not to be included as a computer readable storage medium.

4. An Examiner is obliged to give claims their broadest reasonable interpretation consistent with the specification during examination. The broadest reasonable interpretation of a claim drawn to a computer readable medium (also called machine readable medium and other such variations) typically covers forms of non-transitory tangible media and transitory propagating signals *per se* in view of the ordinary and customary meaning of computer readable media, particularly when the specification is silent. See MPEP 2111.01. When the broadest reasonable interpretation of a claim covers a signal, *per se*, the claim must be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter.

5. Therefore, given the silence of the disclosure and the broadest reasonable interpretation, the computer readable storage medium of the claim may include

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transitory propagating signals. As a result, the claim pertains to non-statutory subject matter.

6. However, the Examiner respectfully submits a claim drawn to such a computer readable medium that covers both transitory and non-transitory embodiments may be amended to narrow the claim to cover only statutory embodiments to avoid a rejection under 35 U.S.C. § 101 by adding the limitation “non-transitory” to the claim. Such an amendment would typically not raise the issue of new matter, even when the specification is silent because the broadest reasonable interpretation relies on the ordinary and customary meaning that includes signals *per se*. For additional information, please see the Patents’ Official Gazette notice published February 23, 2010 (1351 OG 212).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1-16 rejected under 35 U.S.C. 102(e) as being anticipated by Mizumura et al. (US 2002/0001453).

Regarding Claim 1: Mizumura et al. discloses an information record medium on which there are recorded: video information to indicate a main-video (**paragraph 0006**); sub-

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video information to indicate a sub-video displayable at least partially over the main-video (**paragraph 0006**); and sub-video control information including (i) sub-frame range information to indicate at least a partial area of the sub-video as a sub-frame and (ii) sub-frame control information to control displaying the sub-frame to be displayed over the main-video (**paragraph 0006 and 0008**), wherein the sub-frame control information includes dynamic control information to display dynamically the sub-frame (**paragraph 0006 and 0008**).

Regarding Claim 2: Mizumura et al. discloses an information record medium according to claim 1, wherein the dynamic control information includes information to change dynamically at least one of a display position, a display size and a display shape of the sub-frame to be displayed over the main-video (**Fig. 4a-c and fig. 5a-c**).

Regarding Claim 3: Mizumura et al. discloses an information record medium according to claim 1, wherein the dynamic control information includes information to change dynamically a display content within the sub-frame whose display position, display size and display shape are fixed relative to the main-video (**Fig. 4a-c and fig. 5a-c**).

Regarding Claim 4: Mizumura et al. discloses an information record medium according to claim 1, wherein the sub-frame range information designates a rectangular area as the sub-frame, the rectangular area occupying a part of the sub-video(**Fig. 4a-c and fig. 5a-c**), and the dynamic control information has information to change dynamically the display content within the sub-frame by changing the rectangular area designated by the sub-frame range information relative to the sub-video (**Fig. 4a-c and fig. 5a-c**).

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Regarding Claim 5: Mizumura et al. discloses an information record medium according to claim 1, wherein the dynamic control information has information to display dynamically the sub-frame in such a manner that the sub-frame moves two-dimensionally or three-dimensionally relative to the main-video (**Fig. 4a-c and fig. 5a-c**).

Regarding Claim 6: Mizumura et al. discloses an information record medium according to claim 1, wherein the main-video information, the sub-video information and the sub-video control information are divided into predetermined packet units and multiplexed, and further streamed relatively into a video stream composed of the divided main-video information, a sub-picture stream composed of the divided sub-video information and a control information stream composed of the divided sub-video control information (**paragraph 0034**).

Regarding Claim 7-8: Claim 7-8 rejected for similar reason to claim 1 as discussed above.

Regarding Claim 9: Claim 9 rejected for similar reason to claim 1-3 as discussed above.

Regarding Claim 10: Claim 10 rejected for similar reason to claim 1-3 as discussed above.

Regarding Claim 11: Claim 11 rejected for similar reason to claim 1-3 as discussed above.

Regarding Claim 12: Claim 12 rejected for similar reason to claim 1-3 as discussed above.

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Regarding Claim 13: Claim 13 rejected for similar reason to claim 1-3 as discussed above.

Regarding Claim 14: Claim 14 rejected for similar reason to claim 1-3 as discussed above.

Regarding Claim 15: Claim 15 rejected for similar reason to claim 1-3 as discussed above.

Regarding Claim 16: Claim 16 rejected for similar reason to claim 1 as discussed above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL TEKLE whose telephone number is (571)270-1117. The examiner can normally be reached on 7:30am to 5:00pm M-R and 7:30-4:00 Every other Friday..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha D. Banks-Harold can be reached on 571-272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Marsha D. Banks-Harold/
Supervisory Patent Examiner, Art Unit 2621

/Daniel Tekle/
Examiner, Art Unit 2621